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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,583	08/07/2000	Shinako Matsuyama	450101-02142	1141

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EXAMINER

TRAN, TONGOC

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,583

Applicant(s)

MATSUYAMA ET AL.

Examiner

Tongoc Tran

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/14/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's application serial no. 09/581,583 filed on 8/7/2000.

Information Disclosure Statement

2. The information disclosure statement filed 6/14/2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it does not contain the translation for the Japanese prior art. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 13-24, 26-29 and 52-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al. (U.S. Patent No. 6,574,609, hereinafter Downs).

In respect to claim 13, Downs disclose an information providing system comprising an information providing device for providing encrypted information, an information distribution device for distributing the provided information, an information processing device for decoding and using the distributed information, and a management device for managing the information providing device, the information distribution device and the information processing device (see col. Downs, col. 9, line 27-col. 12, line 55); the information providing device having first transmission means for appending information indicating the handling of information to the encrypted information and for transmitting the resultant information to the information distribution device, the information distribution device having calculation means for calculating the use fee of the information on the basis of the information indicating the handling of the information transmitted from the information providing device, and second transmission means for appending the use fee to the encrypted information and for transmitting the resultant information to the information processing device, the information processing

device having accounting information preparation means for preparing accounting information corresponding to the use of the information on the basis of the use fee, and third transmission means for transmitting the accounting information together with a part of or all of the information indicating the handling of information and the use fee to the management device (see Downs, col. 9, line 27-col. 12, line 55 and col. 8, lines 30-40), the management device having detection means for detecting an unauthorized action from a part of or all of the accounting information, the information indicating the handling of information and the use fee (see Downs col. 11, lines 25-40).

In respect to claim 14, Downs disclose the information providing system as claimed in claim 13, wherein the accounting information and the information indicating the handling of information are signed and then transmitted (see Downs, col. 12, line 56-col. 14, line 67).

In respect to claim 15, Downs discloses the information providing system as claimed in claim 13, wherein the accounting information and the information indicating the handling of information are encrypted and then transmitted (see Downs, col. 12, line 56-col. 14, line 67).

In respect to claims 16-17, the claim limitations are substantially similar to claim 13. Therefore, claim 16-17 are rejected based on the similar rationale.

In respect to claim 18, Downs disclose an information providing system comprising an information providing device for providing encrypted information, an information distribution device for distributing the provided information, an information processing device for decoding and using the distributed information, and a

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management device for managing the information providing device, the information distribution device and the information processing device (see Downs, col. 9, line 27-col. 12, line 55), the information providing device having first transmission means for appending information indicating the handling of information to the encrypted information and then transmitting the resultant information to the information distribution device, the information distribution device having second transmission means for transmitting the encrypted information received from the information providing device and the information indicating the handling of information to the information processing device, the information processing device having use permission information preparation means for preparing use permission information corresponding to the use of the information on the basis of the information indicating the handling of information, and third transmission means for transmitting the use permission information together with a part of or all of the information indicating the handling of information to the management device (see Downs, col. 9, line 27-col. 12, line 55), the management device having detection means for detecting an unauthorized action from a part of or all of the use permission information and the information indicating the handling of information (see Downs, col. 11, lines 25-39).

In respect to claim 19, Downs discloses the information providing system as claimed in claim 18, wherein the use permission information and the information indicating the handling of information are signed and then transmitted (see Downs, col. 12, line 56-col. 14, line 67).

In respect to claim 20, Downs discloses the information providing system as claimed in claim 18, wherein the use permission information and the information indicating the handling of information are encrypted and then transmitted (see Downs, col. 12, line 56-col. 14, line 67).

In respect to claims 21-22, the claim limitations are substantially similar to claim 18. Therefore, claims 21-22 are rejected based on the similar rationale.

In respect to claim 23, Downs discloses a management device for managing an information providing device for providing encrypted information and an information processing device for using the information, the management device comprising registration means having ID of the information processing device and data indicating the availability of registration with respect to that ID, for registering the information processing device on the basis of the ID of the information processing device (see Downs, col. 74, lines 22-50)

In respect to claim 24, Downs discloses the management device as claimed in claim 23, wherein the data includes data indicating the possibility of settlement corresponding to the ID (see Downs, col. 74, lines 22-50).

In respect to claims 26-29, the claim limitations are substantially similar to claims 23-24. Therefore, claims 26-29 are rejected based on the similar rationale.

In respect to claim 52, Downs discloses an information processing device for collecting instead of an information provider the use fee from a user of information provided by the information provider and distributing the profit to the information provider, the device comprising: storage means for storing data specifying the

information and data indicating an amount to be paid to the information provider for the use of the information (see Downs, col. 9, line 28-col. 12, line 55);

calculation means for calculating the total amount to be paid to each information provider on the basis of the data stored by the storage means; and settlement instruction means for instructing a settlement institution to settle an account for each information provider on the basis of the profit of each information provider (see Downs, col. 9, line 28-col. 12, line 55).

In respect to claim 53, Downs discloses the information processing device as claimed in claim 52, wherein the calculation means calculates the total amount to be paid between the information providers (see Downs, col. 8, lines 31-39 and col. 9, line 28-col. 12, line 55).

In respect to claim 54, Downs discloses the information processing device as claimed in claim 52, wherein the storage means further stores information related to the amount to be paid to an organization charging for the copyright of the information, the calculation means further calculating the total amount to be paid to the organization, the settlement instruction means further instructing the settlement institution to carry out settlement for the organization (see Downs, col. 18, line 59-col. 9, line 20 and col. 9, line 28-col. 12, line 55).

In respect to claim 55, Downs discloses the information processing device as claimed in claim 52, wherein the storage means further stores data about discount of the use fee for the information (see col. 44, lines 4-22).

In respect to claim 56, Downs discloses the information processing device as claimed in claim 52, wherein the settlement instruction means stores information related to the settlement institution for each information provider (see Downs, col. 44, lines 1-21).

In respect to claims 57-58, the claim limitations are substantially similar to claim 52. Therefore, claims 57-58 are rejected based on the similar rationale.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (U.S. Patent No. 6,574,609) in view of Aziz (U.S. Patent No. 6,330,671) and further in view of Sakajiri (U.S. Patent No. 6,704,419).

In respect to claim 1, Downs discloses an information processing device for receiving encrypted information, an encrypted first key for decoding the information, the device comprising: decoding means for decoding the first key with the second key (see Downs, col. 3, lines 48-67 and col. 76, lines 10-23). Downs does not disclose an information processing device receives the second key. However, Aziz discloses information processing device receiving a key encryption key (see Aziz, col. 2, lines 31-39). Therefore it would have been obvious to one of ordinary skill in the art at the time

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the invention was made to implement the receiving of key encryption key taught by Aziz to prevent it from being discovered enroute to a receiving device (Aziz, col. 2, lines 35-37). Furthermore, Downs does not disclose but Halter discloses requesting means for requesting transmission of the second key when decoding means can not decode the first key (see col. 21, lines 62-lines 68). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made incorporate the teaching of Halter for requesting the re-transmission of the second key with the teaching of Downs and Aziz's receiving encrypted data with encryption key and key encryption key to an information processing device in order to recover a failed key.

In response to claims 2-3, the claim limitations are substantially similar claim 1. Therefore, claims 2-3 are rejected based on the similar rationale.

5. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (U.S. Patent No. 6,574,609) in view of Kleinman et al. (U.S. Patent No. 6,629,243, hereinafter Kleinman) and further in view of Chan (U.S. Patent No. 6,473,860).

In response to claim 4, Downs discloses an information processing device for receiving encrypted information, an encrypted first key for decoding the information and a second key for decoding the first key so as to decode the information, the device comprising: accounting means for executing processing for accounting (see Downs, col. 3, lines 48-67 and col. 76, lines 10-23 and col. 45, line 50-col. 46, line 15); Downs does not explicitly disclose request means for transmission of the second key when an

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accounting value has reached a predetermined value. However, Kleinman discloses distributing key encryption key to only authorized user device (see Kleinman, col. 9, lines 31-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Kleinman's distributing the key encryption key to user device and the teaching of Downs' decoding means and accounting means in order to securely deliver the common keys to all authorized devices (Kleinman, col. 2, lines 51-53). Furthermore, Chan discloses amount of computation needed to decrypt message is different according to the level of security of the message (see Chan, col. 6, lines 50-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Chan's encryption and decryption according to different levels of security with the teaching of Downs to encrypting the first key with the second key so that message with lower level of security can be decoded with less computation need (Chan, col. 6, lines 56-58).

In respect to claims 5-9, the claim limitations are substantially similar to claim 4. Therefore, claims 5-9 are rejected based on the similar rationale.

6. Claims 10-12, 33-39 and 40-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (U.S. Patent No. 6,574,609) in view of Ruroda et al. (U.S. Patent No. 6,421,779) and further in view of Okui (U.S. Patent No. 6,594,758).

In respect to claim 10, Downs discloses an information processing device having first storage means and first decoding means for using encrypted information, an

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encrypted first key for decoding the information and a second key for decoding the first key so as to decode the information (see Downs, col. 3, lines 48-67 and col. 76, lines 10-23); the first storage means comprising first authentication means for carrying out authentication with the first decoding means (see Downs, col. 74, lines 22-58), second storage means for storing the second key, second decoding means for decoding the first key with the second key (see Downs, col. 3, lines 48-67 and col. 76, lines 10-23), the first decoding means comprising second authentication means for carrying out authentication with the first storage means, and fourth decoding means for decoding the information with the first key (see Downs, col. 11, lines 6-24). Downs does not explicitly disclose but Kuroda discloses the devices are mutually authenticated (see Kuroda, col. 11, line 35-line 55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Downs information processing device with the teaching of Kuroda's mutual authentication between two devices ensure the integrity of the received data (Kuroda, Abstract). Furthermore, Downs does not explicitly disclose said second key is a temporary key. However, Okui discloses temporary key is used for transmitting broadcasting information to users (see Okui, col. 1, lines 50-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Okui's temporary key with Downs teaching of encrypting first key with the second key in order to update the key at a predetermined interval (Okui, Abstract).

In respect to claims 33-39, the claim limitations are substantially similar to claim 10. Therefore, claims 33-39 are rejected based on the similar rationale.

In respect to claim 40, Downs discloses an information processing device as claimed in claim 39, wherein the storage means has a tamper-resistant structure (see col. 77, line 62-col. 78, line 7).

In respect to claims 41-42, the claim limitation are substantially similar to claims 36. Therefore claims 41-42 are rejected based on the similar rationale.

In respect to claims 43-46, the claim limitations are substantially similar to claim 10. Therefore, claims 43-46 are rejected based on the similar rationale.

In respect to claims 47-51, the claim limitations are substantially similar to claims 43-45. Therefore, claims 47-51 are rejected based on the similar rationale.

7. Claims 60-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (U.S. Patent No. 6,574,609) in view of Ruroda et al. (U.S. Patent No. 6,421,779).

In respect to claim 60, Downs discloses an information processing device for storing predetermined information to an external storage medium loaded therein, and for decoding encrypted information and using the decoded information, the device comprising:

Encryption means for encrypting predetermined information with a predetermined key (see Downs, col. 9, line 28-col. 12, line 55).

Downs does not explicitly disclose but Kuroda discloses the devices are mutually authenticated (see Kuroda, col. 11, line 35-line 55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

incorporate the teaching of Downs information processing device with the teaching of Kuroda's mutual authentication between two devices ensure the integrity of the received data (Kuroda, Abstract).

In respect to claims 61-66, the claim limitations are substantially similar to claim 60. Therefore, claims 61-66 are rejected based on the similar rationale.

8. Claims 25 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (U.S. Patent No. 6,574,609).

In respect to claim 25, Downs discloses the management device as claimed in claim 23. Downs does not explicitly disclose wherein the registration means registers another information management device subordinate to the information management device communicating with the management device. However, registering means to registers another device before in order to communicate with each other is old and well known (e.g. remote terminal with host). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Downs' teaching of management device authenticating with information processing device to include registering means to register another subordinate device for the purpose of ensuring the device it is communicating is known to the system.

In respect to claims 30-32, the claim limitations are substantially similar to claim 25. Therefore, claims 30-32 are rejected based on the similar rationale.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Ginter et al. Disclose systems and methods for the secure transaction management and electronic rights protection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (703) 305-7690. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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July 23, 2004

Andrew Caldwell
Andrew Caldwell